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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,762	02/15/2005	Werner Bonrath	K21364USWO (C038435/01843)	3414
7590 01/23/2008				
Stephen M Haracz Bryan Cave 1290 Avenue of the Americas New York, NY 10104			EXAMINER GALE, KELLETTE	
			ART UNIT 1621	PAPER NUMBER
			MAIL DATE 01/23/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/524,762

Applicant(s)

BONRATH ET AL.

Examiner

Kellette Gale

Art Unit

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

Claims 1-20 are pending in this application.

The rejection of claims 1-20 has been maintained.

Response to Arguments

Applicant's arguments filed October 9, 2007 have been fully considered but they are not persuasive.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Applicant argues that the Examiner's previous arguments stand un rebutted and for those reasons alone, the rejection should be withdrawn.

The Examiner contends that in the previous response, there was indeed a rebuttal to applicant's arguments and that although they were in the form of contentions,

it was a sufficient response. Applicant argued that there was no case of prima facie obviousness presented that was sufficient enough to maintain the rejection.

The Examiner contends that one of ordinary skill in the art would find it obvious to use any ketone or a ketone that is in close relationship to that which is claimed. The Examiner has pointed out to the applicant that Tedeschi et al has used acetone in their invention. It would be obvious for one of ordinary skill in the art at the time of the instant invention to utilize the disclosure of Tedeschi et al and incorporate any ketone as taught. One of ordinary skill in the art at the time of the instant invention would be motivated to use any ketone especially one which has a close relationship with that which is already taught. Applicant's methyl ethyl ketone has a close homologous relationship with acetone. Therefore, one of ordinary skill in the art at the time of the instant invention would not only find it obvious to do so, but would be motivated to use methyl ethyl ketone and any other homolog to that which is taught in order to prepare the corresponding acetylenic alcohol.

Applicant has also issued a declaration with a showing of unexpected results. After careful consideration of the disclosure of Tedeschi et al and the showing of unexpected results, the Examiner has concluded that Tedeschi et al's ratio of alkali metal hydroxide to ketone is within the claimed range. This information shows that it would be obvious for one of ordinary skill in the art at the time of the instant invention to optimize their process results by utilizing any such ratio within the range disclosed. Please see column 2, lines 60-64 to see that the ratio quoted previously by the Examiner was incorrect. The ratio seen here has a range of 0.5-0.001; wherein that

which is claimed equals to about 0.005. One having ordinary skill in the art would find it obvious to utilize any such ratio within that which has been disclosed including one which is equal to 0.005.

Also, applicant's showing of unexpected results merely shows an optimization of process parameters. The high ratio is in direct proportion to a high conversion to product; whereas as a low ratio shows a low conversion to product. Although it is also shown that a high ratio yields a higher by-product percentage than that of a low ratio, this information merely shows optimization of the process parameters and this information is not held as patentably distinct information.

Therefore, for the reasons stated above and for those found in the previous office actions, the rejection of claims 1-20 under 35 USC 103(a) as being unpatentable over Tedeschi et al (US 3,709,946) is maintained.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kellette Gale whose telephone number is (571) 272-8038. The examiner can normally be reached on M-F (6:30am-3:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, YVONNE EYLER can be reached on 571-272-0871. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Kellette Gale
Patent Examiner
Technology Center 1600

January 16, 2008



Samuel Barts
Primary Patent Examiner
Technology Center 1600